REMARKS

In the Office Action mailed July 9, 2004, claims 1-11, 16-21 and 23-24 stand rejected under 35 U.S.C. § 102(b), and claims 12-15 and 22 stand rejected under 35 U.S.C. § 103(a). After a careful review of the pending Office Action and the cited references, Applicant respectfully requests consideration in view of the following remarks.

I. 35 U.S.C. § 102(b) Claim Rejections

A. Claims 1-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rose et al., U.S. Patent No. 5,752,244 (Rose).

To anticipate a claim, each and every element set forth in the claim must be found in a single reference. (MPEP § 2131). Applicant submits that Rose does not teach a media player including "a content database for storing the at least one organizational task to be executed upon connection of the player to a content source," as in claim 1 and similarly in claim 8. (*See* claim 8, e.g., accessing a database within the player ... [that] provides a list of content files that includes files not existing on the player, the selection of content files being associated with content files in the list," "connecting the player to a source of content," and then "executing at least one predefined rule to perform at least one operation on at least one content file associated with the selection of content files").

As mentioned by Applicant in the response to the Office Action mailed October 14, 2003, Rose does not teach a media player including a content database, which manages relationships between content selections and content files, that is separate from a media or content source. For example, in presently claimed embodiments, a user can create a play list and store the play list in the content database on the player, and upon connection to a content source, the player can pull

content files within the play list from the content source to the player. (Specification, p. 4 line 25 to p. 5 line 10).

In contrast, Rose teaches checking-out or downloading multimedia assets from a system by connecting a client computer through a communications network to a server, and then selecting assets to download. Rose does not teach pre-selection of content to download on the media player, e.g., such as "a content database" on the media player "for storing the at least one organizational task to be executed upon connection of the player to a content source," as in claim 1 and similarly in claim 8. Thus, since Rose does not teach all limitations of pending claim 1 or 8, then Rose fails to anticipate claims 1-11.

B. Claims 16-21 and 23-24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Perkes, U.S. Patent Application document number 2003/0110503 (Perkes).

Applicant submits that Perkes does not teach a "method of adding content on a portable media player" comprising "adding the selection of content files to a database within the player," "determining if any content files in the list of content files do not exist on the player," "connecting the player to a source of content," and then "adding any content files from the list of content files not already existing on the media player," as in claim 16 and similarly in claim 19.

Perkes teaches a network in which the computers are always connected to the Internet. The computers download a client program and request a server to push information to the computer through the program. For example, the computers can access an extended programming guide (XPG) through a set top box that includes TV schedules, and the user then selects programs to download. (Perkes, ¶0265). Thus, the computers use their IP connection to periodically download program data including TV schedules, from a database. (Perkes, ¶0267).

7

Since Perkes teaches computers always connected to the Internet to access the TV schedules, Perkes does not teach a "method of adding content on a portable media player" comprising "adding the selection of content files to a database within the player," "determining if any content files in the list of content files do not exist on the player," "connecting the player to a source of content," and then "adding any content files from the list of content files not already existing on the media player," as in claim 16 and similarly in claim 19. Thus, Perkes does not teach all the claim limitations of claims 16 or 19, and does not anticipate claims 16-21 and 23-24.

II. 35 U.S.C. § 103(a) Claim Rejections

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), there must be some suggestion or motivation to combine or modify the cited references, and the cited references must teach or suggest all the claim limitations. (MPEP § 2142).

Claims 12-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rose in view of Perkes, and claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Perkes. Applicant submits that neither Rose nor Perkes, separately or in combination, teach or suggest "accessing a database within the player ... [that] provides a list of content files that includes files not existing on the player, the selection of content files being associated with content files in the list," "connecting the player to a source of content," and "executing at least one predefined rule to perform at least one operation on at least one content file associated with the selection of content files," as in claim 8 and similarly in claim 19.

However, the Examiner asserts that Perkes teaches deleting a content file from the media player, as in claim 12. (Office Action, p. 7). Applicant disagrees. Perkes teaches that once

content has been downloaded and arranged by the content manager function, the user may then delete the content. (¶0061). Thus, Perkes does not teach selecting files to be deleted, and upon connection to the source of content, then responsively deleting the files, as in claims 12-15 and similarly in claim 22.

III. Summary

Applicants respectively submit that in view of the remarks above, all of the pending claims 1-24 are in condition for allowance and such action is respectively requested. The Examiner is invited to call the undersigned at (312) 913-0001 with any questions or comments.
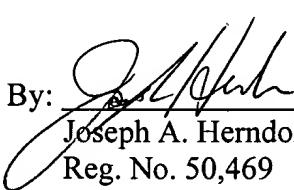
Respectfully submitted,

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9